

REMARKS

The Examiner is thanked for his Office Action.

Applicant respectfully notes that the paragraph numbers in the application as filed and the paragraph numbers in the published application appear to differ slightly in some cases. When paragraph numbers are used herein, they refer to the published version of the application (US 2005/0071750).

Claims 1-19 are pending in the application.

Claims 1-19 have been rejected.

Claims 8 and 17 were objected to for typographical errors. Said typographical errors are herein amended as set forth herein. Claims 10 and 18 are amended to ensure that are statutory subject matter; these amendments are supported, *e.g.*, in paragraphs 0036-0040 of the specification as filed. Claims 1, 2, 8, 9, 10, 11, 15, 17, and 18 were also amended to correct inconsistent language in the originally-filed claims.

REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. §1.105

The undersigned attorney first notes that neither this firm nor any attorney employed by this firm drafted this application or worked with the inventor, and the file was transferred here for prosecution more than a year after filing. Neither predecessor firm, Hulsey & Calkins LLP and Hulsey Grether + Fortkort LLP, appear to exist in that form any more. Further, the inventor on this application is no longer employed by the assignee company, and is not participating in the

prosecution of this application. As of the time of filing, the undersigned has been unable to discuss this case with the inventor. As such, all the responses below to the Examiner's Requirement for Information are made to the best of the undersigned's ability, upon review of the application and file as transferred to this firm. By the answers below, the undersigned does not intend to waive any attorney-client privilege or other privilege with regard to matters not subject to disclosure under 37 CFR 1.56.

1. The Examiner requires a list of keywords relating to the art of symbol-type mark-up language spreadsheets and/or symbol type XML files.

The information required to be submitted is unknown to or is not readily available to the undersigned or the assignee of this application. Were the undersigned doing such searching, terms such as METIS, SYMBOL XML, SYMBOL SPREADSHEET, SDG STANDARD, and METAMODEL would be used. Several figures in the filed application, including, for example, figure 10A, include URL statements.

2. The Examiner requires a citation to any art related to the description of the prior art in the specification, relied upon to draft the claimed subject matter, or any products known to incorporate prior art systems.

The information required to be submitted is unknown to or is not readily available to the undersigned or the assignee of this application. However, some materials in the file indicate that at least some of the disclosure in the present application may be intended to be an improvement on an object-oriented modeling and metamodeling application such as the Computas SA product "Metis". Several figures in the filed application, including, for example, figure 10A, include

URL statements, and some of these include a reference to “metis”. The only document in the file that appears potentially relevant as prior art is one labeled “Help System for Metis Client Tools” version 3.3 with a Computas copyright date of April 2003. This is submitted with an accompanying IDS, but no representation is made as to whether or not this article constitutes prior art under 35 USC 102 as it is unknown when, if ever, this document may have been publicly available. It is also unknown to what extent, if any, the attorney(s) drafting this application relied upon this document in drafting the prior art description or the claims.

Another statement in the file indicates that the inventor believed that due to the nature of their products, companies such as Popkin, PTech, and CaseWise may have produced something similar, but that the inventor was unaware of any specific product or product feature produced by any of these companies that would compete with the disclosed invention. The undersigned is not personally familiar with any of these companies or their products.

Another statement in the file makes general reference to the Microsoft spreadsheet application Excel as a known spreadsheet application.

3. The Examiner also requires the names of any products or services that have incorporated the claimed subject matter.

The information required to be submitted is unknown to or is not readily available to the undersigned or the assignee of this application.

4. The Examiner also requires an identification of the specific improvements of the subject matter in claims 1-19 over the disclosed prior art and an indication of the specific elements in the claimed subject matter that provide those improvements. The

Examiner asks for specific citations in the specification to support any means-plus-function or step-plus-function in the claims.

The information required to be submitted is unknown to or is not readily available to the undersigned or the assignee of this application. The undersigned has reviewed the “Help System for Metis Client Tools” version 3.3 document, and while it certainly mentions a definition of “metamodel”, it does not appear to discuss metamodel requirements, a requirement spreadsheet, object mark-up language spreadsheet file, relationship type mark-up language spreadsheet, a symbol XML spreadsheet, or a plurality of metamodel type files. As such, it would appear that the entirety of the claims may be an improvement over the system discussed in this document.

None of the claims includes means-plus-function or step-plus-function terms. As this is the case, it is unclear why the Examiner would request such support for non-existent language.

With regard to any other information requested or required by the Examiner, the information required to be submitted is unknown to or is not readily available to the undersigned or the assignee of this application. The undersigned does apologize for the circumstance that makes any further information related to the drafting of this application unavailable, and for any inconvenience this causes to the Examiner.

CLAIM REJECTIONS -- 35 U.S.C. §112

Claims 1-19 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner contends that the terms “symbol

type spreadsheet” and “symbol type mark-up language file” have insufficient support in the specification to enable one of skill in the art to practice the invention.

While the Examiner appears to be correct that the only specific user of the specific phrase “symbol type XML files” is found in paragraph 0062, Applicant respectfully notes that the abstract as filed indicates that the “symbol type spreadsheet” corresponds to element 188. Element 188 is described in the specification as “oSymbolClip spreadsheet 188” (paragraph 0066). Paragraphs 0075 and 0076 describe the contents and use of the Symbol XML spreadsheet, and describes that oSymbolClip spreadsheet 188 provides the symbol XML text for the symbol XML file of the metamodel system. Figure 11 shows the specific contents of an exemplary oSymbolClip spreadsheet 188.

Applicant therefore respectfully asserts that one of skill in the art could practice the invention by using the exemplary oSymbolClip spreadsheet 188 contents as shown in Figure 11 as the claimed “symbol type spreadsheet” and “symbol type mark-up language file” to practice at least one embodiment of the present invention. By providing specific exemplary code to implement the invention, the application does in fact enable one of skill in the art to practice the invention.

Claims 1-19 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim amendments made herein are believed to obviate any antecedent-basis issues.

With regard to “object type” and “relationship type”, the specification describes, *e.g.* in

paragraph 0046, that a metamodel defines object types and relationship types. One of ordinary skill in the art would recognize, for example, that the claimed object type mark-up language spreadsheet is a mark-up language spreadsheet containing metamodel object types, and the claimed relationship type mark-up language spreadsheet is a mark-up language spreadsheet containing metamodel relationship types. Paragraph 0065 describes, for example, that a symbol is a graphical representation of an object or relationship in a model. Applicant therefore believes that one of ordinary skill in the art would recognize that the claimed symbol type mark-up language spreadsheet is a mark-up language spreadsheet containing metamodel symbol types.

The indefiniteness rejections are therefore traversed, particularly in light of the amendments made above.

CLAIM REJECTIONS -- 35 U.S.C. §101

Claims 10-19 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. Claims 10 and 18 were amended above, and this rejection is believed obviated and is therefore traversed.

CLAIM REJECTIONS -- 35 U.S.C. §103

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (*Fed. Cir.* 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re*

Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

Claims 1-4, 6-13, and 15-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over what the Examiner characterizes as "Applicant admitted prior art" (hereinafter "AAPA") in further

view of *Delcambre, et al.* (U. S. Pat. App. Pub. US 2002/0059566 A1, hereinafter “Delcambre”).

These rejections are traversed.

Claim 1 requires “generating at least one each of an object type mark-up language spreadsheet, a relationship type mark-up language spreadsheet, and a symbol type mark-up language spreadsheet by applying a predetermined set of generation instructions to said at least one requirements spreadsheet”. Nothing in AAPA or Delcambre teaches or suggests this limitation, and the Examiner makes no showing of where this is taught or suggested in any art of record. As such, claims 1-9 should be allowed over all art of record, and the rejection of these claims is traversed.

Claims 10 and 18 require “instructions for generating at least one each of an object type mark-up language spreadsheet, a relationship type mark-up language spreadsheet, and a symbol type mark-up language spreadsheet by applying a predetermined set of macros to said at least one requirements spreadsheet”. Nothing in AAPA or Delcambre teaches or suggests this limitation, and the Examiner makes no showing of where this is taught or suggested in any art of record. As such, claims 10-19 should be allowed over all art of record, and the rejection of these claims is traversed.

In general, also, AAPA does not appear to teach or suggest mark-up language spreadsheets, and these are also not taught or suggested by Delcambre.

Claims 5 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA and Delcambre as applied to claims 1 and 10 above and in further view of *Jamshidi, et al.* (U. S. Pat. App. Pub. US 2004/0181748 A1, hereinafter “Jamshidi”).

As the limitations discussed above are also not taught or suggested by Jamshidi, alone or in combination with the other references, these rejections are also traversed.

All rejections are traversed.

With regard to the particular combination of art used by the Examiner, there does not appear to be a proper motivation to combine AAPA and Delcambre. While the Examiner has stated a motivation and quoted language from Delcambre, it is unclear what Delcambre's flow diagram for structural mapping has to do with the claimed symbol type mark-up language spreadsheet, and Applicant assumes that this is a result of some of the inconsistent language used in the originally-filed claims.

As the claims have now been amended, and all non-art-related rejections and other matters have been addressed, Applicant respectfully awaits a further action on the merits.

CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

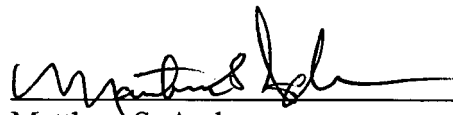
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at manderson@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS P.C.

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